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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Application Number: 09/938,485
Filing Date: August 27, 2001
Appellant(s): KARIYA, CHIKAKO

Stephen T. Boughner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/25/2007 appealing from the Office action mailed

12/26/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings

which will directly affect or be directly affected by or have a bearing on the Board's decision in

the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in

the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5890177   MOODY   3-1999

"Getting Results with Microsoft 97", Microsoft Corp., 1997, pp.365-394, and 396-401.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims 1-8, 10-18, 20-27, 29-37, 39-46, and 48-56 remain rejected under 35

U.S.C. 103(a) as being unpatentable over Moody et al, hereinafter Moody (Pat.# 5,890,177,

3/30/1999), in view of "Getting Results with Microsoft Office 97", hereinafter Office, Microsoft

Corporation, 1997, pages 396-401, and newly added pages 365-394.

Regarding independent claim 1, Moody discloses comparing an original document and an

edited copy of the same document to determine similarities, and differences, if any, among the

documents, which are separately emailed among an author and editors—*the documents are*

electronic mail documents (col.7, lines 21-67, col.4, lines 34-51).

Furthermore, Moody discloses the comparison of similarities and differences—*relevance*

information-- between paragraphs of two documents emailed between the author, and editors—

exchange history of the electronic mail documents-- such as an original document, and an edited

copy of the original document (which was edited, after the original document was created—

timewise latest document--based on a heritage —*header*-- containing a timestamp—*timewise*

order-- indicating when the document was created or edited) (col.10, lines 15-35, col.4, lines 34-

51). Moody fails to explicitly disclose *the documents are electronic mail; branching of separate*

emails from a first email, with the branching of emails including at least two distinct time-wise

non-sequential emails branching from the first email on a same branch of the branching of

emails and/or at least two distinct time-wise sequential emails branching from the first email on

different branches of the branching of email. However, Office teaches sending a copy of the

document a user is working on, to a recipient as an email, and allowing a user to group various

email transmitted separately in time, in response to a specific email, such as a conference

registration request (page 399, 366-372,376-379). In other words, the emailed messages sent in

reply to the registration request, depend on or branch from the email request, and were sent at

various times. It would have been obvious to one of ordinary skill in the art at the time of the

invention to have combined Moody, and Office, because of all the reasons found in Office

including getting quick feedback from reviewers, and making it easy to handle emails (page 396,

and 376). This would provide the efficient, and time-saving benefit of directly emailing the

documents the user has created using the sophisticated features of the application, such as the

wordprocessing application.

Regarding claim 2, which depends on claim 1, Moody discloses the comparison of

similarities or differences between paragraphs of two documents, based on a creator ID —*header*

information (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 3, which depends on claim 2, Moody discloses presenting or displaying

the documents and their similarities and differences—*relevance information*-- in a visible way

using techniques such as redlining, in a marked up document in a tree-like order with the original

document on top followed by the edited copies—*outputs the relevance information in a timewise*

order-- (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 4, which depends on claim 1, Moody discloses presenting or displaying

the documents and their similarities and differences in a visible way using techniques such as

redlining, in a marked up document in a tree-like order with the original document on top

followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 5, which depends on claim 4, Moody discloses presenting or displaying

the documents and their similarities and differences in a visible way using techniques such as

redlining, in a marked up document in a tree-like order with the original document on top

followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 6, which depends on claim 5, Moody discloses presenting or displaying

the documents—*document selected at the locator*-- and their similarities and differences in a

visible way using techniques such as redlining, in a marked up document in a tree-like order with

the original document on top followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-

35, fig.3).

Regarding claim 7, which depends on claim 2, Moody discloses the comparison of

differences—*branched state*-- between paragraphs of two documents, based on a creator ID —

header information according to a uniqueness rule in each of the documents. The differences or

edits—*detected branched state*-- are presented in a visible way using techniques such as

redlining (col. 6, lines 1-67, col.10, lines 15-35).

Regarding claim 8, which depends on claim 5, Moody discloses the comparison of

differences—*branched state*-- between paragraphs of two documents, based on a creator ID —

header information according to a uniqueness rule in each of the documents. The differences or

edits—*detected branched state*-- are presented in a visible way using techniques such as

redlining , in a marked up document in a tree-like order with the original document on top

followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 10, which depends on claim 1, discloses returning edited copies of the

original document back to the author using email—*the documents located by the locator are*

subjected to a return mail processing. The documents are arranged in a hierarchical tree-like

order in a markup document (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

The limitations of independent claim 11 are substantially similar to the limitations in

claim 1, and therefore similarly rejected, except for, Moody discloses a word processing software

for deleting duplicate paragraphs of the documents, and producing a final document (col.7, lines

1-20). In other words, the software is used to go through all the paragraphs and removes the

duplicate paragraphs, and creates a final document without the duplicate paragraphs—*parsing*

overlapped portion of information and for merging the documents with the overlapped portion

eliminated. A comparison of similarities and differences—*relevance information*-- between

paragraphs of two documents emailed among the author, and editors—*exchange history of the*

electronic mail documents—is determined by the software.

Regarding claim 12, which depends on claim 11, Moody discloses the merging of the

final document by using a document containing various editions of the original document

organized in an order that presents the original paragraphs first, followed by other edited

paragraphs—*merges the documents according to an order of the related documents* (col.6, lines

56-67, fig.3).

Regarding claim 13, which depends on claim 11, Moody discloses the comparison of

paragraphs based on an on heritage containing an ID of the editor who made the edits to the

corresponding document—*detect relevance among the documents based on the header*

information or editor initials (col.10, lines 15-35).

Regarding claim 14, which depends on claim 13, Moody discloses the comparison of

paragraphs of two documents, based on a heritage —*header*-- containing a timestamp—*timewise*

order-- indicating when the document was created or edited—*detect relevance among the*

documents based on the header information or editor initials. The differences or edits are

presented in a visible way using techniques such as redlining, in a marked up document in a tree-like order with the original document on top followed by the edited copies—*timewise order* (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Regarding claim 15, which depends on claim 11, Moody discloses the display of a markup document containing various editions—*relevance documents--* of the original document organized in a tree order that presents the original paragraphs first, followed by other edited paragraphs (col.6, lines 56-67, fig.3).

Regarding claim 16, which depends on claim 15, Moody discloses using the markup document containing various editions, and which is displayed in a tree order, for producing, and displaying a final document creating by merging several of the edited documents—*relevance documents--* of the original document organized in an order that presents the original paragraphs first, followed by other edited paragraphs (col.6, lines 56-col.7, line 20, fig.3).

Regarding claim 17, which depends on claim 13, Moody discloses the comparison of differences—*branched state--* between paragraphs of two documents, based on a creator ID — *header information according to a uniqueness rule in each of the documents.* The differences or edits—*detected branched state--* are presented in a visible way using techniques such as redlining (col. 6, lines 1-67, col.10, lines 15-35).

Regarding claim 18, which depends on claim 15, Moody discloses the comparison of

differences—*branched state*-- between paragraphs of two documents, based on a creator ID —

header information according to a uniqueness rule in each of the documents. The differences or

edits—*detected branched state*-- are presented in a visible way using techniques such as

redlining, in a marked up document in a tree-like order with the original document on top

followed by the edited copies (col. 6, lines 1-67, col.10, lines 15-35, fig.3).

Claims 20-37 are directed towards a computer program product on a computer-readable

medium for performing the steps found in claims 1-18 respectively, and therefore are similarly

rejected.

Claims 39-46, 48-56 are directed towards a method for implementing the device found in

claims 1-8, and 10-18, respectively, and therefore are similarly rejected.

(10) Response to Argument

The Appellant indicates that the documents discussed in Moody are not electronic mail

documents (page 12, parag.2). Moody teaches an author emailing copies of an original document

to multiple editors, which after receiving those copies edit, and send them back via a means, such

as email (col.4, lines34-51). Moody fails to explicitly teach that *the documents are email.*

However, Office teaches sending a copy of the document a user is working on, to a recipient as

an email, directly from the application being used to produce the document, and allowing a user

to group various email transmitted separately in time, in response to a specific email, such as a

conference registration, or document review request (page 399, 366-372,376-379). It would have

been obvious to one of ordinary skill in the art at the time of the invention to have combined

Moody, and Office, because of all the reasons found in Office including getting quick feedback

from reviewers, and making it easy to handle emails (page 396, and 376). This would provide the

efficient, and time-saving benefit of directly emailing the documents the user has created using

the sophisticated features of the application, such as the wordprocessing application.

The Appellant also submits that "the claimed emails must be capable of having an email

exchange history of a branching of separate emails from a single email", page 12, parag.3.

Moody teaches determining whether the document emailed from the editors, and the original

document belong to the same family of documents, or have a heritage in common—*exchange*

history of the documents. This determination is made by looking for a creator ID, and a

timestamp, indicating when the documents were first created (col.10, lines 15-35). Moody fails

to explicitly teach *exchange history of a branching of separate emails from a single email.*

However, Office teaches sending an copy of the original document a user is working on, to a

recipient as an email, directly from the application being used to produce the document, and

allowing a user to group various email transmitted separately in time, in response to a specific

email, such as a document review request (page 399, 366-372,376-379). **In other words, the**

emails sent back in response to the email of the original document comprise separate

branches of the original email sent to the receiving users. It would have been obvious to one

of ordinary skill in the art at the time of the invention to have combined Moody, and Office,

because of all the reasons found in Office including getting quick feedback from reviewers, and

making it easy to handle emails (page 396, and 376). This would provide the efficient, and time-

saving benefit of directly emailing the documents the user has created using the sophisticated features of the application, such as the wordprocessing application.

In addition, the Appellant submits that the "documents discussed in Moody et al. would at most only be considered attachments to emails, and any relevance information maintained for such documents is document specific and unrelated to the actual email that forwarded that attachment", page 12, parag.4. Although the documents referred to by <u>Moody might be considered email attachments, the documents discussed by Office are the email body contents themselves (page 399, parag. 3)</u>, so with the combination of Moody, and Office the similarities, and differences found in the documents would be found in the email contents, and not in attachments as purported by the Appellant.

Moreover, the Appellant submits that "the documents discussed in Moody et al. are not separately created, i.e., the documents in Moody et al. are all copies of the same document and would all be created at the same time", page 12, parag.5. The Examiner disagrees, because the document created by the author, and those transmitted by the editors are created after the author sends the original document to the editors to be edited. Therefore, they cannot be created at the same time, because the contents added or edited into the document by the editors or reviewers is done after having received the document from the author. <u>The document does not remain static, it is modified by adding and editing data.</u>

Moreover, the Appellant submits that " any relevance information for any of the

documents discussed in Moody et al. would not include (or need) any information regarding the

branching of the same. Rather, in Moody et al., the intention is for the author to send out copies

of the documents to reviewers and the reviewers to send the edited copies directly back to the

author..", page 12, parag.6-7. As it was indicated above, Office teaches sending an copy of the

original document a user is working on, to a recipient as an email, directly from the application

being used to produce the document, and allowing a user to group various email transmitted

separately in time, in response to a specific email, such as a document review request (page 399,

366-372,376-379). **In other words, the emails sent back in response to the email of the**

original document comprise separate branches of the original email sent to the receiving

users.

Moreover, the Appellant submits that " Here, however, as noted in previous responses,

'emails' are fundamentally different from 'Word' documents, and any emailing of documents

within an email is merely that, 'within an email.' The documents are not the emails themselves,

but rather either attachments or **copies of the same copied and pasted into the body of the**

emails", page 13, parag.4. As it was indicated above, Office teaches sending an copy of the

original document a user is working on, to a recipient as an email, directly from the application

being used to produce the document, and allowing a user to group various email transmitted

separately in time, in response to a specific email, such as a document review request (page 399,

366-372,376-379). The Appellant also seems to agree with the fact that the document is the

content of the email or the email body itself **(this is also evidenced by Wolf-USPat. 5818447, in**

col.16, liens36-65, and fig.11, where the email body comprises the document in an RTF

format), so when the search for similarities and differences is undertaken, the program described

by Moody would be searching the email messages taught by Office (which were a reply to the

original email sent to the reviewers by the author of the document-- *branching of separate emails*

from a first email with *at least two distinct time-wise sequential emails branching from the first*

email on different branches of the branching of email) themselves, and not the attachment. It

would have been **clearly obvious—not forced--** to one of ordinary skill in the art at the time of

the invention to combine Moody, and Office, so that the email messages would be searched, and

their content compared, and contrasted to determine similarities and differences between the

original document, and the edited versions of the documents submitted by the reviewers via

email, because of all the reasons found in Office including getting quick feedback from

reviewers, and making it easy to handle emails (page 396, and 376). **This would provide the**

efficient, and time-saving benefit of directly emailing the documents the user has created

using the sophisticated features of the application, and comparing the original document

and its children or replied documents, at the inbox where the messages were received

(Office, fig. in page 377).

Further, the Appellant indicates that "[T]here is no discussion or need for any sequential

or non-sequential time review to be performed on either of the sending of the copied documents,

the edits with the copied documents, or receipt of the edited documents. Similarly, if Moody et

al. were interpreted as encapsulating the text of the document within an email, Moody et al.

would not care about the timewise information or branching of the email from an original email,

but rather would care about relevance information about the text from the document put into the

body of the email" page 14, parag.1. The Examiner disagrees, because the emailed documents

would be transmitted by the reviewers separately (Moody, col.4, lines 44-51), and placed in the

author's inbox (Office, fig. in page 377, as it was well-known in the art at the time of the

invention). The combination of Moody and Office could allow the search of the inbox for the

latest replied messages, branching off the original message,--*email exchange history*---

containing the edited documents. The original message being the parent message, and the

response or replied email messages comprising the children or branches of the original message.

Once found, the program disclosed by Moody would activate a comparison routine to compare

the contents of the original email document to the children or branch email documents, stored in

the inbox, that were sent by the reviewers in response to the email request of the author.

As indicated above, Office is not completely unrelated to Moody, as proposed by the

Appellant (page, 16, parag.2). Moody is directed towards the comparison of documents received

within email messages. Office discloses an originator sending an original document directly from

an application, **as the body of the email, and not as an attachment,** to various reviewers who

then edit, and send back the edited documents to the originator within email messages (pages

399, 396-397). The email messages are then placed, and displayed on an inbox window, which

includes various filtering portions (page 377). Moody fails to explicitly disclose *the documents*

are electronic mail; branching of separate emails from a first email, with the branching of

emails including at least two distinct time-wise non-sequential emails branching from the first

email on a same branch of the branching of emails and/or at least two distinct time-wise

sequential emails branching from the first email on different branches of the branching of email.
It would have been obvious to one of ordinary skill in the art at the time of the invention to have
combined Moody, and Office, to search, and ***compare the latest (timewise) replied email***
messages found in the inbox shown by Office, which contain the edited documents, with the
original document taught by Moody, because of all the reasons found in Office including getting
quick feedback from reviewers, and making it easy to handle emails (page 396, and 376). This
would provide the efficient, and time-saving benefit of directly emailing the documents the user
has created using the sophisticated features of the application, such as the wordprocessing
application, and comparing the original document and its children or replied documents, at the
inbox where the messages were received, with the original document.

Moreover, the Appellant submits that "[M]oody et al. would not care or need to know
when an email (containing an edited document) was received. Moody et al. only cares that the
compared document is of the same heritage, i.e., has the identical timestamp and from the same
original author" page 16, parag.7). The Examiner disagrees, because the claim language does
not preclude the interpretation of locating a latest document associated with a document, based
on some detected relevance information, such as the similarities or differences of related email
documents, **such as the latest (timewise) replied edited documents that need to be compared**
to the original document (as rejected by the Examiner). The limitation does not recite the
determination of the time the email was received as suggested by the Appellant. The claim
rather recites the location of a latest document based on some relevance information, such as the
history of branching of separate emails from a first email. **The relevance information is not the**
time the email was received as the Appellant's emphasis appears to be.

Regarding claims 2-3, 13-14, 21-22, 32-33, 40-41, and 51-52, the Appellant submits that

"it is unclear how the Examiner is interpreting the claimed document or the clamed relevance

information, i.e., if the document is an email body then there may not be any author-ID

information recorded with the text, while if the document is only a Word document with such a

creator-ld header information then the document cannot be "an email" as proposed by the

Examiner. If the document is an email, then the creator-ID probably does not exist in the

modified <u>Moody et al.</u> having such an email document, and if the document is merely a

document, e.g., attached to an email, then the modified <u>Moody et al.</u> fails to disclose the claimed

email aspect of the invention", page 18, parag.6-7. As stated above, the Examiner's is

interpreting the document to be the body of the email, which does not destroy the creator id and

timestamp taught by Moody, since the email contains the document information, and the email

header information separately within the email message (**as it is evidenced by Office's sending**

a copy of the whole document (which would include the formatting information, such as the

creator id, timestamp, etc.), and Wolf-USPat. 5818447, in col.16, liens36-65, and fig.11,

where the email contains email header, and the body comprises the document in an RTF

format).

Regarding claims 6, 16, 25, 35, 44, 54, and in response to appellant's argument that the

references fail to show certain features of appellant's invention, it is noted that the features upon

which appellant relies (i.e., "the Office Action relies upon FIG. 3 of Moody et al., showing a

merging of paragraphs. However, Moody et al. fails to disclose that the claimed tree view is

based upon a located timewise latest document. As noted above, Moody et al, does not care

about the differences in time between edits only that the edits are of the same heritage

document", page 19, parag.1) are not recited in the rejected claim(s). Although the claims are

interpreted in light of the specification, limitations from the specification are not read into the

claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The claims do

not recite that the claimed tree view is based upon a located timewise latest document.

Regarding dependent claims 7-8, 17-18, 26-27, 36-37, 45-46, and 55-56, and in response

to appellant's argument that the references fail to show certain features of appellant's invention,

it is noted that the features upon which appellant relies (i.e., "the Appellant submits regarding

claim 7, that "the Office Action' here has interpreted 'branched state' as meaning differences

between documents, presumably based upon the term 'branch' meaning 'branching' from the

original documents. However, it is respectfully submit that this interpretation of 'branched state'

is incorrect and does not cooperate with the detailed description. Though a reasonable

interpretation may be given to a feature, any interpretation must not run counter to the detailed

description's use of the same. The detailed description clearly provides multiple examples of

what 'branched' is meant to mean in view of the term 'electronic email document.' Further, the

detailed description explains how documents can be timewise branched" page 18, parag.3-6.)

are not recited in the rejected claim(s). Although the claims are interpreted in light of the

specification, limitations from the specification are not read into the claims. See *In re Van*

Geuns, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The Appellant is invited to include in

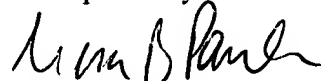the claim the part of the specification that details the timewise branching of the emails.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related

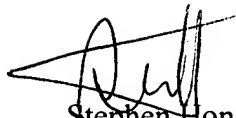Appeals and Interferences section of this examiner's answer.

Conclusion

For all of the reasons stated above the Examiner believes that the rejections should be
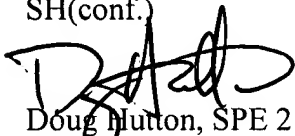
sustained.

Respectfully submitted,

CESAR PAULA
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